



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,745	08/18/2000	Robert A. Rosania	9567-3	7327

570 7590 10/17/2003

AKIN GUMP STRAUSS HAUER & FELD L.L.P.  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103-7013

EXAMINER
----------

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
----------	--------------

1713

DATE MAILED: 10/17/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/641,745

Applicant(s)

ROSANIA ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 December 1899.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-4, 6-19 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-4, 9, 11-19 and 30 is/are allowed.
- 6) ☒ Claim(s) 6-8 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6, 7 & 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

**Continued Examination Under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07.28.03 has been entered.

**Information Disclosure Statement**

2. Applicant's information disclosure statements of 12.06.00(paper no. 6), 05.10.02(paper no. 7) and 07.28.03(paper no. 14) have been considered and placed in the application file. As to the IDS statements per papers 6 & 7, the documents cited thereon were considered on 09.05.02 and initialed copies were mailed, as an attachment, with the Office Action per paper no.10, 09.11.02. However, since Counsel per page 6 of the "AMENDMENT AFTER FINAL" response of paper no. 15, 07.28.03 indicated that initialed copies of the Information Disclosure Statements had not been received, an initialed copy of such is herein being resubmitted as an attachment to the current Office Action. As to the IDS of paper no. 14, 07.28.03, while the references have been crossed out, each of these documents were cited on an earlier FORM PTO/SB/08A and have already been considered.

**Claim Rejections - 35 USC § 112**

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described

Art Unit: 1713

in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As far as the Examiner can tell, no express support can be found for the newly recited limitation “number average” molecular weight and, as such, without any guidelines from Counsel as to where support might be found, this engenders a New Matter situation.

**Claim Rejections - 35 USC § 112**

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The recited “wherein the carrier vehicle is at least one of a homopolymer or a copolymer selected from the group consisting of cellulose, polyacrylics, polyurethanes, polyesters, polyvinyls, polyamides, polyolefins, and derivatives” per claim 6 constitutes indefinite subject matter as per the metes and bounds of “copolymers” and “derivatives” engender indeterminacy in scope.

B) The recited “further comprises a polyurethane” per claim 8 constitutes indefinite subject matter as per it not being readily ascertainable as to how such further limits the antecedently recited “polyurethanes”, i.e., it is not clear if the recited polyurethane is the same as or in addition to the antecedently recited “polyurethanes”. It is suggested that the term “further” be deleted so as to avoid any confusion.

**Allowable Subject Matter**

7. Claims 2-4, 6-19 and 30 are deemed allowable over the prior art of record as per said art neither anticipating nor rendering obvious the meticulously defined near infrared absorbing agent-governed liquid composition, as claimed. One having ordinary skill in the art would not

Art Unit: 1713

have been endowed with any motivation to extrapolate the precisely defined near infrared absorbing agent-governed liquid composition from any of the prior art of record with any reasonable expectation of success. Claims 2-4, 9, 11-19 and 30 are allowed. Claims 6-8 and 10 would be allowed if rewritten and/or amended so as to obviate the 112 issues raised supra.

#### **Response to Arguments**

8. Applicant's arguments of paper no. 13, filed 07.28.03, with respect to the rejection of claims 2, 6-9, 11-13, 15 and 16 under 35 USC 102(e)/103 over Haldankar, the rejection of claims 10 and 14 under 35 USC 103(a) over Haldankar and the rejection of claims 2-4 and 6-19 under 35 USC 102(b)/103 over Hattori et al, Akiyama et al or Oi et al have been fully considered and are persuasive. The rejections have been withdrawn.

9. Applicant's arguments filed 07.28.03 have been fully considered but they are not persuasive.

Relative to the 112 issues---While Counsel, in a good faith effort, attempted to remedy the 112 issues raised in the previous Office Action(paper no. 10, 09.11.02), some issues remain and new issues were created and are as set forth supra. As to "derivatives", with all due respect to Counsel's opinion, the metes and bounds of "derivatives", especially in this context, engender indeterminacy in scope.

#### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

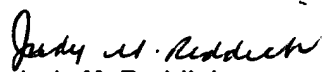
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.


Application/Control Number: 09/641,745

Page 5

Art Unit: 1713

  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR

  
10.09.02